

REMARKS

Note regarding pending claims and entry of amendments

Applicant has amended independent claim 1 to recite the limitations of dependent claim 17. Claim 17 has been cancelled. Claims 19-24 were previously cancelled, and claims 25-29, which were previously withdrawn, have now been formally cancelled.

Applicant submits that entry of these amendments is proper, even after the final office action, for two reasons. First, the amendments place the present patent application in better condition for appeal. That is, Applicant contests the rejection of claim 17, and by making claim 17 an independent claim via incorporating its limitations into independent claim 1, this puts the claims in better condition for appeal.

Second, Applicant notes that no new search is required on the part of the Examiner to consider the added claim limitations of claim 1. These claim limitations are not new; the Examiner has previously performed a search on these claim limitations, and has considered these claim limitations, in the context of claim 17. That is, no new subject matter has been added to claim 1 that was not already present in the claims as a whole. As such, the Examiner does not need to perform a new search to consider claim 1 as amended.

Claim rejections under 35 USC 103

Claims 1, 3-4, 6, 10, and 18 have been rejected under 35 USC 103(a) as being unpatentable over Okubo (4,336,597) in view of Nagao (2001/0028964), and further in view of Tateishi (5,086,421). Claims 5 and 9 have been rejected under 35 USC 103(a) as being unpatentable over Okubo in view of Tateishi (and presumably Nagao) and further in view of Greene (5,805,460). Claims 11-16 have been rejected under 35 USC 103(a) as being unpatentable over Okubo in view of Tateishi and Nagao and further in view of Ito (5,608,717). Claim 17 has been rejected under 35 USC 103(a) as being unpatentable over Okubo in view of Tateishi and Nagao and further in view of Anderson (2003/0179674).

As noted above, claim 1 has been amended to recite the limitations of claim 17, and claim 17 has been cancelled. Therefore, claim 1 effectively stands rejected on the same grounds as claim 17 was, over Okubo in view of Tateishi and Nagao, and further in view of Anderson. However, Applicant submits that Anderson is not properly relied upon as prior art to the present patent application, as is now discussed in detail.

The present patent application has a filing date of August 29, 2003. Anderson was filed on March 20, 2002, and was published on September 25, 2003. Therefore, Anderson is prior art under 35 USC 102(e). Note that Applicant is not saying that some of the claims of the present patent application were rejected under 35 USC 102(e), but rather that Anderson is a 102(e) reference used in rejecting some of the claims under 35 USC 103(a). This is because Anderson was filed before the present patent application was filed, but was published after the present patent application was filed.

Applicant submits that Anderson was commonly owned with the present patent application at the time the invention of the present patent application was made, such that Anderson cannot be considered prior art pursuant to 35 USC 103(c). Pursuant to the requirements promulgated under MPEP sec. 706.02(l)(2)II.,¹ Applicant provides the following section.

¹ This section of the MPEP states that the “statement concerning common ownership should be clear and conspicuous (e.g., on a separate piece of paper or in a separately labeled section) Applicants *may*, but are not required to, submit further evidence . . . in addition to the above-mentioned statement concerning common ownership. For example, an attorney . . . [i]n her response for Application X states, in a clear and conspicuous manner that ‘Application X and Patent A were made at the time the invention of Application X was made, owned by Company Z.’ This statement alone is sufficient evidence to disqualify Patent A from being used in a rejection under 35 USC 103(a) against the claims of Application X.”

**COMMON OWNERSHIP OF US PATENT APPLICATION 2003/0179674 AND
PRESENT PENDING US PATENT APPLICATION 10/652,004 AT THE TIME OF THE
INVENTION OF PATENT APPLICATION 10/652,004 WAS MADE**

Applicant hereby submits that US patent application 2003/0179674 and the present pending US patent application 10/652,004, at the time the invention of patent application 10/652,004 was made, were commonly owned by, and/or subject to an obligation of assignment to the same party, Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

Therefore, insofar as Anderson is not properly considered prior art, claim 1 is patentable – and Applicant traverses the rejection of claim 1 under 35 USC 103(a) – for this reason. The remaining pending claims are patentable at least because they depend from a patentable base independent claim, claim 1.

Conclusion

Applicants have made a diligent effort to place the pending claims in condition for allowance, and request that they so be allowed. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Mike Dryja, Applicants' Attorney, at 425-427-5094, so that such issues may be resolved as expeditiously as possible. For these reasons, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,



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Date

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